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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/027,440	12/20/2001	Sandip H. Mandera	884.623US1	1921
21186 7590 12/28/2006 SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A. P.O. BOX 2938 MINNEAPOLIS, MN 55402			EXAMINER RUHL, DENNIS WILLIAM	
			ART UNIT	PAPER NUMBER
			3629	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		12/28/2006	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/027,440

Applicant(s)

MANDERA, SANDIP H.

Examiner

Dennis Ruhl

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-25 and 32-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22-25, 32-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Applicant's response of 10/10/06 has been entered. The examiner will address applicant's remarks at the end of this office action.

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 41-44 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The examiner believes that the scope of the means plus function language used in claim 44 includes human beings. As an example, for claim 41, with respect to the limitation of "means for choosing a peer using the response", the examiner believes that this limitation can include a human being, which renders the claims non-statutory. As is discussed in the 112,2nd rejection, it is not clear as to what the scope of the means language is, but absent any guidance from the specification that this limitation is not a human and taking into account the broadest reasonable interpretation, the examiner has concluded that this limitation includes a human being in its scope. The same is true for the other means limitations. The functions that are recited for the 112,6th limitations all can be performed by a human being. The means for requesting a remaining portion of the service request from the peer can also be a human being. The claims are found to be non-statutory because they have a scope that includes human beings.

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3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 22-25,32-44, are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Applicant has claimed an apparatus or a system that has a server and a second electronic device, where the 2nd electronic device is to receive a service request from a first electronic device, to "fulfill a portion of the service request", and to find a 3rd electronic device to send a remaining portion of the service request to. In the instant specification applicant has disclosed that the "services" may comprise both goods and services, very broad language left open to anything. The examiner does not feel that the specification provides an enabling disclosure of how the electronic device actually fulfills the service request and finds another electronic device that can fulfill a remaining portion of the service request. Because the scope of the claims allow for the service request to be a request such as a request to have a clothes washer fixed, or to be a request to have a furnace fixed, how does the electronic device(s) fulfill the service request? One of skill in the art would not know how to go about making an electronic device that can fulfill a service request such as fixing a furnace in the home of a customer or fixing a clothes washer. How does the electronic device go to the home of

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the customer and fix the furnace? This is more or less what the claims are reciting.

There is insufficient teaching as to how the electronic device is made so that it can actually fulfill any kind of service request. The examiner also does not see any kind of sufficient disclosure that would enable one of skill in the art to make an electronic device so that it can find another electronic device to fulfill the remaining portion of the service request. How is this done? If the service request is to have the oil changed in a car and the air conditioning serviced, how does the 2nd electronic device change the oil? One of skill in the art would have no idea how to make the 2nd electronic device perform such as activity. How does the electronic device know that a given automotive service provider can change the oil but cannot do the AC service, and from there, how does the 2nd electronic device then find another electronic device that can perform the AC servicing? How then does the 3rd electronic device perform the AC servicing? This is not taught in the instant specification. The examiner does not feel that one of skill in the art after reading the disclosure would be able to make the apparatus or system as claimed so that it can perform the recited intended use. The claims are not enabled by the specification.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 41-44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For claim 41, applicant is using means plus function language (112,6th) to define the invention. Upon consulting the specification for guidance on what specific structure or acts are covered by the claimed means plus function limitations, the examiner finds that it is not clear as to what structure is covered by the recited means language. The specification must make it reasonably clear to one wishing to avoid infringement what structure is covered by any means plus function language used in the claims. In the instant case, upon consulting the specification for guidance on the scope of the means plus function language, it is not clear what structure is covered by this language. As an example, what structure is covered by the language "means for receiving a service request and fulfilling a portion of the service request"? What single structural element performs both of these functions? This is not clear. The means to receive the service request might possibly be a modem and/or modem driver software, but what is the element that not only receives the service request, but also fulfills a portion of the request? What one structural element does both of these functions? This is not clear. What is the means for receiving a response to the registry? It is not clear as to what structure is covered by this language. Is this an internal communication bus of some kind? What is the means for choosing a peer? Is this possibly a human being? Is this just software code? What structure performs the step of choosing a peer? One wishing to avoid infringement would not know what structure is covered by the claimed 112,6th means plus function language; therefore the claims are considered indefinite.

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7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 22-25,32-35,39-41,43, are rejected under 35 U.S.C. 102(b) as being anticipated by Rondeau (5850433).

For claims 22,32, Rondeau discloses an online service directory where a customer can search for a desired service by using a first electronic device (a computer). There is a registry server (28 and 14) that contains descriptive information about services that are available and that satisfies what is claimed. The 2nd electronic device is 18. The network/network adapter is 32. With respect to the language reciting that the 2nd electronic device is “to fulfill a portion of the service request received.....and to send a remaining portion of the service request to a 3rd electronic device...” a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963). In this case, the claimed intended use imparts no further structure to the claim and is solely directed to the intended manner of use. Applicant should take notice that all the claim recites

structurally is a server, a registry, and an electronic device (singular). This is anticipated by Rondeau. Concerning the ability of the electronic device of Rondeau to perform the claimed intended use, the examiner notes that the claims do not require that there is no human interaction involved in the fulfilling of the service request and in the finding of a 3rd electronic device. The electronic device of Rondeau is fully capable of being used by a human being to fulfill a portion of a service request (can be the ordering of goods from an online merchant) and to find another provider that can perform a given service. The electronic device of Rondeau can be used in a manner claimed due to the fact that a human being can be the one actually instructing the electronic device on what to do.

For claims 23-25,33-35,40, these claims are reciting the intended use of the apparatus and are also anticipated by Rondeau for the same reasons as explained with respect to claims 22,32. There is no 3rd electronic device in the scope of the claims because the 3rd electronic device is only claimed in a function sense (it is just part of the intended use of the 2nd electronic device). Applicant has not positively claimed that there is in fact another electronic device in the apparatus or system that is being claimed.

For claim 41, as best understood by the examiner due to 112,2nd issues, Rondeau discloses a means for receiving a service request (modem and/or driver software). The means to send a registry request to the registry server is inherent to Rondeau. Because Rondeau sends a search request to the server to locate a service provider, there must necessarily be a means to send a registry request to the server as

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claimed. Also inherent is the means to receive a response from the registry server. If you send a request to the server and receive a response as is done in Rondeau, there must necessarily be a means to receive a response as claimed. The means for choosing a peer is the portion of the search programming that selects appropriate peers from the listing contained in the server. The means for requesting a remaining portion of the service request from the peer is the customer computer. The customer is fully capable of using their computer to send a request to the peer that was identified from the server.

For claims 39,43, the examiner wants to point out that the actual service request itself is not part of the scope of the claims and is not a positively claimed element, so reciting what format it has is not really reciting any further structure to the system or is not reciting any further structure to one of the recited elements of the system. The service request is not positively claimed as a claimed element and is not even a real work structural thing. The service request is just what the claimed apparatus or system is used with but is not part of the apparatus or the system. Rondeau satisfies what is claimed.

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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10. Claim 36-38,42,44, are rejected under 35 U.S.C. 103(a) as being unpatentable over Rondeau (5850433).

For claims 36,37,42,44, Rondeau does not disclose that the registry server is implemented in XML and that the format of the messages/requests is XML. XML is a well-known language that was developed to make sharing of information on the Internet easy. This kind of language is old and well known to one of ordinary skill in the art, and the examiner takes official notice of this fact. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have Rondeau use Extensible Markup Language so that the sharing of information can be easy as the creators of XML envisioned.

For claims 37 (even though it has been addressed immediately above), the examiner wants to point out that the actual service request itself is not part of the scope of the claims and is not a positively claimed element, so reciting what format it has is not really reciting any further structure to the system or is not reciting any further structure to one of the recited elements of the system. The same applies to claim 39. The service request is not positively claimed as a claimed element and is not even a real work structural thing. The service request is just what the claimed apparatus or system is used with but is not part of the apparatus or the system. Rondeau satisfies what is claimed.

For claim 38, Rondeau does not disclose that the registry server is implemented in EDI. EDI is a well-known computer language that is old and well known to one of ordinary skill in the art, and the examiner takes official notice of this fact. It would have

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been obvious to one of ordinary skill in the art at the time the invention was made to have Rondeau use Electronic Data Interchange (EDI) language because one of ordinary skill in the art would recognize that language as one of the choices available and because it is known to work. EDI, just like XML, is old and well known in the art and is obvious to one of ordinary skill in the art.

11. Applicant's arguments filed 10/10/06 have been fully considered but they are not persuasive.

With respect to the traversal of the 112,1st rejection, it is found to be non-persuasive. Applicant has argued that the scope of the claims does not include the situation where the request for service is for to have a clothes washer fixed, which is what the enablement rejection is in part based on. Applicant has argued that the term "service request" as used in computer arts has a particular meaning with a particular format. Applicant further has argued that "as used in the instant application", the services requested are services that can be performed at least partially by the electronic device receiving the request for service. With respect to the term "service request" and the argument that this term has a recognized meaning in the computer arts, no evidence to support this position has been provided to the examiner for review and applicant has not actually explained to the examiner exactly what this term requires. If this term has a particular meaning in the computer arts, an explanation of what that meaning is should have been presented. With respect to the argument that the

specification discloses that the services are services that can be partially performed by an electronic device, where is this set forth in the specification as originally filed? The specification as originally filed on page 3 states "*As used herein "services" may encompass both goods and/or services*". This is a non-limiting definition for the term "services" so the argument that the term "service request" does not have a scope that includes a request for service for a clothes washer is non-persuasive and is not commensurate with the scope of the specification as originally filed. The originally filed specification allows for the services that are being requested to be any kind of services. The specification does not support the claim language interpretation that applicant has argued. The claims are still considered to be non-enabled for the reasons set forth by the examiner in the rejection of record.

Applicant has further argued that with respect to the second electronic device, the service request may be considered partially fulfilled by simply sending a response to the service request. The examiner disagrees with this statement. Simply sending a response to the service request is not seen as constituting a partial fulfillment of the service request itself. The examiner does not agree that a response to a service request can be considered as a partial fulfillment of the services that were requested. No service has even been provided by just sending a response, the problem that the customer is having is not even partially fixed by just a response. Applicant's argument does not address how the 3rd electronic device will go about and fulfill the request to have a clothes washer fixed, as is claimed (see claim 23). Applicant is reciting that an electronic device is fulfilling the service request, but one of skill in the art would not be

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able to make the claimed invention (how does the electronic device fix the clothes washer?) because applicant has not disclosed how they fulfill the service request with an electronic device, when the service request is for any kind of goods or services (which is what the specification discloses).

Concerning the traversal of the 102 rejection, the argument is found to be non-persuasive. Applicant has argued that they see no basis in fact that would support the assertion that Rondeau could respond partially to the request for a phone number, passing the remained of the request to another device. The language *"to fulfill a portion of the service request received from a first electronic device, and to send a remaining portion of the service request to a third electronic device found using the registry server"* is directed to the intended use of the claimed apparatus. The claimed intended use imparts no further structure to the claim and is solely directed to the intended manner of use. Concerning the ability of the electronic device of Rondeau to perform the claimed intended use, the examiner notes that the claims do not exclude human interaction in the fulfilling of the service request and in the finding of a 3rd electronic device. The electronic device of Rondeau is fully capable of being used by a human being to fulfill a portion of a service request (can be the ordering of goods from an online merchant) and to find another provider that can perform a given service. The electronic device of Rondeau can be used in a manner claimed due to the fact that a human being can be the one actually instructing the electronic device on what to do. Rondeau is fully capable of what is claimed because a human being can use the second electronic device to send the service request to a third electronic device. Applicant has trying to

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get apparatus claims allowed based on the intended use of the recited structure. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

With respect to the 103 rejection, applicant has correctly noted that the examiner has taken official notice; however, applicant's traversal is not adequate and is not persuasive. To be a proper challenge to the taking of official notice, applicant must set forth "the supposed errors in the examiner's action, *which would include stating why the noticed fact is not considered to be common knowledge or well known in the art*", see MPEP 2144.03. Applicant has not actually stated that the facts asserted by the examiner to be well known are not well known in the art. In fact, applicant never actually stated that they disagree with the statement by the examiner that XML is well known. Applicant's traversal just amounts to a request for a cited document that supports the taking of official notice, which is not an adequate traversal. Because applicant has failed to set forth an adequate traversal to the taking of official notice in the rejection of record, the statements of fact set forth by the examiner are taken to be admitted prior art.

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 571-272-6808. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



DENNIS RUHL
PRIMARY EXAMINER